

Remarks

In the Office Action mailed July 24, 2003, Claims 1-7, 9 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,714,428 issued to Le-Khac et al.

Applicants confirm the correctness of the Examiner's presumption at page 3 of the instant Office Action regarding ownership of the presently claimed subject matter.

Rejections under 35 U.S.C. §103(a)

Claims 1-7, 9 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,714,428 issued to Le-Khac et al. Applicants respectfully disagree with the Examiner's contention regarding Le-Khac et al.

Applicants' citation of the admonition given in *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1458-9 (Fed. Cir. 1998) was not made to support the mistaken proposition given by the Examiner at page 6 of the instant Office Action that Applicants are arguing that, "the examiner must show that patentees are solving the same problem as the inventor and provide reasons therefore." The citation of *In re Rouffet* was made to remind the Examiner that her duty in making a rejection under 35 U.S.C. §103 is to show reasons that the skilled artisan (not the patentees), confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art reference(s) for combination in the manner claimed. Applicants contend the Examiner has failed to point to any teaching or suggestion to one of ordinary skill to select the elements from the cited art and thus lead to the instantly claimed invention.

Applicants reiterate that Le-Khac et al. only provide a listing of functionalized polymer categories that they deem suitable in their "other preferred catalysts of the invention..." (col. 4, line 66), with the preferred functionalized polymers being disclosed at col. 4, lines 29-65. Therefore, Applicants submit that Le-Khac et al. provide neither guidance nor suggestion of the claimed catalyst containing an aliphatic polycarbonate having a hydroxyl end group and an average molecular

weight below 12,000, as determined by measurement of the OH number. Le-Khac et al. provide no example of any polycarbonate-containing catalyst.

Furthermore, as to the Examiner's contention that no "problem" is stated in the instant specification, Applicants respectfully disagree and direct her attention to page 2, lines 7-15 of the instant specification.

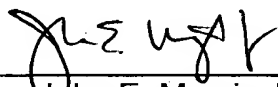
Therefore, Applicants contend that nothing in the teaching of Le-Khac et al. would lead one of ordinary skill in the art to the instantly claimed invention and respectfully request the Examiner reconsider and reverse her rejection of Claims 1-7, 9 and 10 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,714,428 issued to Le-Khac et al.

Conclusion

Applicants have made no claim amendments as they believe the pending claims to be patentable over the cited art.

Applicants submit that the instant application is in condition for allowance. Accordingly, reconsideration and a Notice of Allowance are respectfully requested for Claims 1-7, 9 and 10. If the Examiner is of the opinion that the instant application is in condition for other than allowance, she is invited to contact the Applicants' Attorney at the telephone number listed below, so that additional changes to the claims may be discussed.

Respectfully submitted,

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